The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte PIERRE A. LAVALLEE

_____

Appeal No. 1998-1337
Application 08/351,102

_____

ON BRIEF

_____

Before KRASS, FLEMING and RUGGIERO, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims pending in the present application.

The invention relates to an apparatus and method for optimally compressing image data containing pictorial and text images.

Independent claim 1[1] is reproduced as follows:

1. An image compression apparatus comprising:

means for generating a first set of control signals indicating whether image data contains pictorial image data or text image data based upon image characteristics;

first encoding means for encoding the image data in accordance with a first encoding scheme optimized for pictorial image data;

second encoding means for encoding the image data in accordance with a second encoding scheme optimized for text image data, as the first encoding means encodes the image data; and

control means for receiving encoded image data from both the first encoding means and the second encoding means and for selecting encoded image data from one of the first and second encoding means based upon the first set of control signals.

---

[1] We note that the proper claims before us are the claims provided by Amendment C, an after final amendment. The Examiner states on page 2 of the Examiner's answer that "Amendment 'C', paper number 15, filed with the Appeal Brief has been entered."

The references relied on by the Examiner are as follows:

Robinson	5,339,172	Aug. 16, 1994
Kimura et al. (Kimura)	5,392,362	Feb. 21, 1995

Claims 1 through 5 and 8 through 12 stand rejected under 35 U.S.C. § 102 as being anticipated by Kimura. Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kimura. Claims 7 and 13 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kimura in view of Robinson.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs[2] and answer for the details thereof.

OPINION

[2] Appellant filed an appeal brief on June 3, 1997. Appellant filed a reply brief on October 3, 1997. The Examiner mailed a communication on November 12, 1997 stating that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

After careful review of the evidence before us, we do not agree with the Examiner that claims 1 through 5 and 8 through 12 are anticipated by Kimura.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellant argues that Kimura does not disclose every element or claim recitation as required under § 102. Appellant

argues on page 6 of the brief that Kimura does not disclose concurrent encoding of image data using more than one encoder. Appellant argues that appellant's claims require two encoders to encode image data and a controller to select data from one of the two encoders after the image data has been encoded by the two encoders. In particular, appellant points to claim 1 as well as claim 9 language which requires second encoding

means encoding image data in accordance with a second encoding scheme as first encoding means encodes the image data. Appellant also points out that claim 1, and similarly claim 9, recite a control means receiving encoding image data from both the first encoding means and the second encoding means and select encoding image data from one of the first and second encoding means. Appellant argues that these recitations make it clear that first and second encoding means encode image data in parallel and that the encoded data is received from both first and second encoding means at the control means.

On page 9 of the answer, the Examiner responds to these arguments by stating that concurrent encoding is not recited in the claims. The Examiner does not dispute that Kimura does not
in any way disclose concurrent encoding of image data using more

than one encoder. The Examiner argues that the term "as" does not necessarily mean "concurrently." The Examiner argues that "as" can mean "to the same extent or degree."

On pages 4 and 5 of the reply brief, Appellant argues that the only reasonable interpretation of "as" is that the second encoding means encodes while the first encoding means encodes. Appellant argues that the Examiner's interpretation of "as" as recited in claims 1 and 9 is faulty. On page 2 of the reply brief, Appellant points to support for the first and second encoding means operating in parallel in the specification and drawings. In particular, Appellant points us to figure 1; page 8, lines 15 through 17; page 9, lines 17 through 19; and page 13, lines 4 through 10 of the specification. Appellant argues that when the originally filed specification is considered as a whole, it is clear that one aspect of the invention includes a control means simultaneously receiving encoded image data from first and second encoding means that are operating concurrently.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest

reasonable interpretation consistent with the specification, and
limitations appearing in the specification are not to be read into the claims. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5, (Fed. Cir.), ***cert. denied***, 474 U.S. 828 (1985).

When reading Appellant's specification as a whole, we find that the term "as" would mean "while." In particular, we note that Appellant's figure 1 shows the first and second encoding means connected in parallel. Furthermore, we note that on page 8 of the specification, Appellant discloses that the first and second encoding means operate in parallel and provide data to control unit 180. On page 9, Appellant discloses that the control unit selectively stores the image data compressed by encoder 140 or encoder 170 in accordance with the determined image type. Appellant further points out that it is the control unit 180 that determines the image type. Appellant discloses on page 13 that the apparatus compresses the image data using parallel compressors and selects the compressed image data from

the compressors based upon the detected image characteristics. Therefore, we find ample support in the specification for the interpretation of the term "as" found in claims 1 and 9 as meaning "while." In other words, appellant's claimed invention
requires the first and second encoders to be operating in

parallel concurrently. However, we find no support in the specification for the Examiner's interpretation of "as."

In view of this finding, we will not sustain the Examiner's rejection of claims 1 through 5 and 8 through 12 under 35 U.S.C. § 102 as being anticipated by Kimura. Furthermore, we note that the rejection of claims 6, 7, and 13 through 20 under 35 U.S.C. § 103 is based upon the above interpretation of the term "as." Therefore, we will not sustain the Examiner's rejection of these claims for the same above reasons.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 20 is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)	

MRF:psb

Appeal No. 1998-1337
Application 08/351,102

Finnegan Henderson Farabow Garrett & Dunner
1300 I Street, N.W.
Washington, D.C. 20005